

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 15436.366.1											
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/814,483	Filed March 31, 2004											
	First Named Inventor Gerald L. Dybsetter												
	Art Unit 2111	Examiner Nimesh G. Patel											
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding: 5px;">/Ronald J. Ward/Reg. No. 54,870</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding: 5px;">Signature Ronald J. Ward</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>54,870</u></td><td style="vertical-align: top; padding: 5px;">Typed or printed name (801) 533-9800</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding: 5px;">Telephone number October 24, 2008</td></tr><tr><td></td><td style="vertical-align: top; padding: 5px;">Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/Ronald J. Ward/Reg. No. 54,870	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature Ronald J. Ward	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>54,870</u>	Typed or printed name (801) 533-9800	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number October 24, 2008		Date
<input type="checkbox"/> applicant/inventor.	/Ronald J. Ward/Reg. No. 54,870												
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature Ronald J. Ward												
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>54,870</u>	Typed or printed name (801) 533-9800												
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number October 24, 2008												
	Date												
<input type="checkbox"/> *Total of _____ forms are submitted.													

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Filed Electronically

PATENT APPLICATION

Docket No. 15436.366.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
	Gerald L. Dybsetter)
Serial No.:	10/814,483) Art Unit
) 2111
Filed:	March 31, 2004)
For:	TWO-WIRE INTERFACE IN WHICH A)
	MASTER COMPONENT MONITORS THE)
	DATA LINE DURING THE PREAMBLE)
	GENERATION PHASE FOR)
	SYNCHRONIZATION WITH ONE OR)
	MORE SLAVE COMPONENTS)
Confirmation No.:	7758)
Customer No.:	22913)
Examiner:	Nimesh G. Patel)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Final Office Action mailed July 25, 2008 (the "Final Office Action") and the Advisory Action mailed October 10, 2008 (the "Advisory Action"), Applicants respectfully request a panel review of the rejection discussed in the remarks below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal.

Reconsideration of the application by a panel of examiners is respectfully requested in view of the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the clear errors in the rejection.

REMARKS

Claims 1-40 are pending, of which claims 1, 23, and 28 are independent. In the Final Office Action, the Examiner rejected claims 1-5, 8-10, 12, 13, 23-26, and 28-30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,385,669 to *Creedon et al.* (“*Creedon*”) and rejected claims 6, 7, 11, 14-22, 27, and 31-40 under 35 U.S.C. § 103 as being unpatentable over *Creedon* in view of what is purportedly “well known in the art.”¹

Applicants submit, however, that the rejection relies on assertions of inherency that do not meet the legal standard required for establishing inherency and that the rejection relies on certain mischaracterizations of *Creedon*. Applicants respectfully submit that these deficiencies, which are discussed below in more detail, constitute clear errors. Therefore, withdrawal of the rejection is respectfully requested.

As mentioned in *Applicants’ paper dated September 23, 2008*, the Examiner has made a variety of characterizations of *Creedon*, none of which appear to have been necessitated by claim amendments. In the Advisory Action, the Examiner provided a detailed explanation of “how *Creedon* is interpreted” in response to Applicants’ requests for clarification on these various characterizations. For purposes of brevity, the present paper will address the most recent interpretation of *Creedon* provided by the Advisory Action. As to the Examiner’s previous characterizations, the remarks made in Section III of *Applicants’ paper dated September 23, 2008* are respectfully incorporated.

Claims 1, 23, and 28, although of different scope, each recite, among other things, “an act of monitoring [a] data wire of [a] two-wire interface upon determining that [an] operation is to be performed on [a] slave component.” With respect to this limitation, the Examiner relied on a theory of inherency, alleging, for example, that “[t]o communicate in *Creedon*’s system, the master [i.e., station management entity 10] is required to communicate a preamble of 32 consecutive ones...[and] [i]t is inherent the master has to monitor the data wire for 32 consecutive logic ones to meet the preamble requirement.” See Advisory Action, Continuation Sheet. (Emphasis added.)

As an initial matter, Applicants respectfully note that allegations of inherency are not readily established. For example, as noted in MPEP § 2112, the Examiner must provide rationale or evidence showing inherency. In particular, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original). Moreover, the Court of Appeals for the Federal Circuit has noted that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described by the

¹ The Final Office Action also rejected claim 40 under 35 U.S.C. § 112, first paragraph. However, the rejection under section 112 was withdrawn in the Advisory Action.

reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). Finally, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The assertions that Creedon “is required to communicate a preamble” and that “it is inherent the master has to monitor the data wire for [the preamble]” (emphases added) are not purported to be based on a specific teaching in *Creedon*, but in fact appear to be improperly based on the Examiner’s personal knowledge. Moreover, the Examiner has mischaracterized *Creedon* in asserting that a preamble is “required” and that station management entity 10 (i.e., the master) “has to monitor” for the preamble. In fact, according to *Creedon*, the preamble may be omitted: “[I]f the management entity determines that every physical layer device that is connected to receive the MDIO signal can accept management frames that are not preceded by the preamble pattern, then such a preamble pattern may be omitted.” *See Creedon*, col. 5, lines 1-5 (emphasis added.)

The Examiner’s discussion of *Creedon* attempted to show why station management entity 10 inherently must monitor the data line for its own preamble. For example, the Examiner asserted:

While [station management entity 10] is communicating this preamble, any component on the bus is able to tie the clock down to zero. If a component does tie the data wire to zero during this phase, then the requirement of 32 consecutive logic ones is not met [and] synchronization is not achieved.

See Advisory Action, Continuation Sheet. Elsewhere, the Examiner similarly asserted, “One skilled in the art would recognize, in such a bus structure, if [the master] does not monitor the data wire for the correct preamble, errors can occur and synchronization will not be achieved.” *See id.* However, the foregoing assertions are similar to the assertions of inherency discussed above in that they appear to be improperly based on the Examiner’s personal knowledge. Moreover, the description provided by *Creedon* strongly indicates otherwise. For example, according to *Creedon*, the “management data input/output bus line 13” (i.e., the data wire) “is used for both conveying frames to the physical layer device 11 and for receiving data back from the device 11.” Therefore, among the purposes designated for bus line 13, *Creedon* does not mention management entity 10 using bus line 13 to monitor for its own preamble.

Applicants respectfully submit that the foregoing remarks demonstrate clear errors in the rejection. Therefore, Applicants respectfully submit that claims 1, 23, and 28 are not anticipated by

Creedon, at least because the Examiner has not properly established inherency and because the Examiner has mischaracterized *Creedon*. Applicants thus respectfully submit that the rejection of claims 1, 23, and 28, and corresponding dependent claims 2-5, 8-10, 12, 13, 24-26, 29, and 30, should be withdrawn.

Applicants further note that inasmuch as the rejection of claims 6, 7, 11, 14-22, and 31-39 relies on the characterization of *Creedon* advanced by the Examiner in connection with the rejection of claims 1 and 28, the rejection of claims 6, 7, 11, 14-22, and 31-39 lacks an adequate basis for at least the reasons set forth in the discussion above. Accordingly, the attention of the Examiner is respectfully directed to such discussion. For example, it was noted in such discussion that the Examiner has failed to establish that *Creedon* teaches all the limitations of claims 1 and 28, from which claims 6, 7, 11, 14-22, and 31-39 depend. Thus, Applicants respectfully submit that it is clear that even if the references are combined, the resulting combination fails to include all the limitations of claims 6, 7, 11, 14-22, and 31-39.

CONCLUSION

In view of the discussion submitted herein, Applicants respectfully submit that each of the pending claims 1-40 is in allowable form. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; and/or (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

Dated this 24th day of October, 2008.

Respectfully submitted,

/Ronald J. Ward/Reg. No. 54,870

RONALD J. WARD

Registration No. 54,870

ERIC L. MASCHOFF

Registration No. 36,596

Attorneys for Applicant

Customer No. 022913

Telephone: (801) 533-9800